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IN THE
Supreme Court of the United States
OCTOBER TERM, 1944

No. 1067

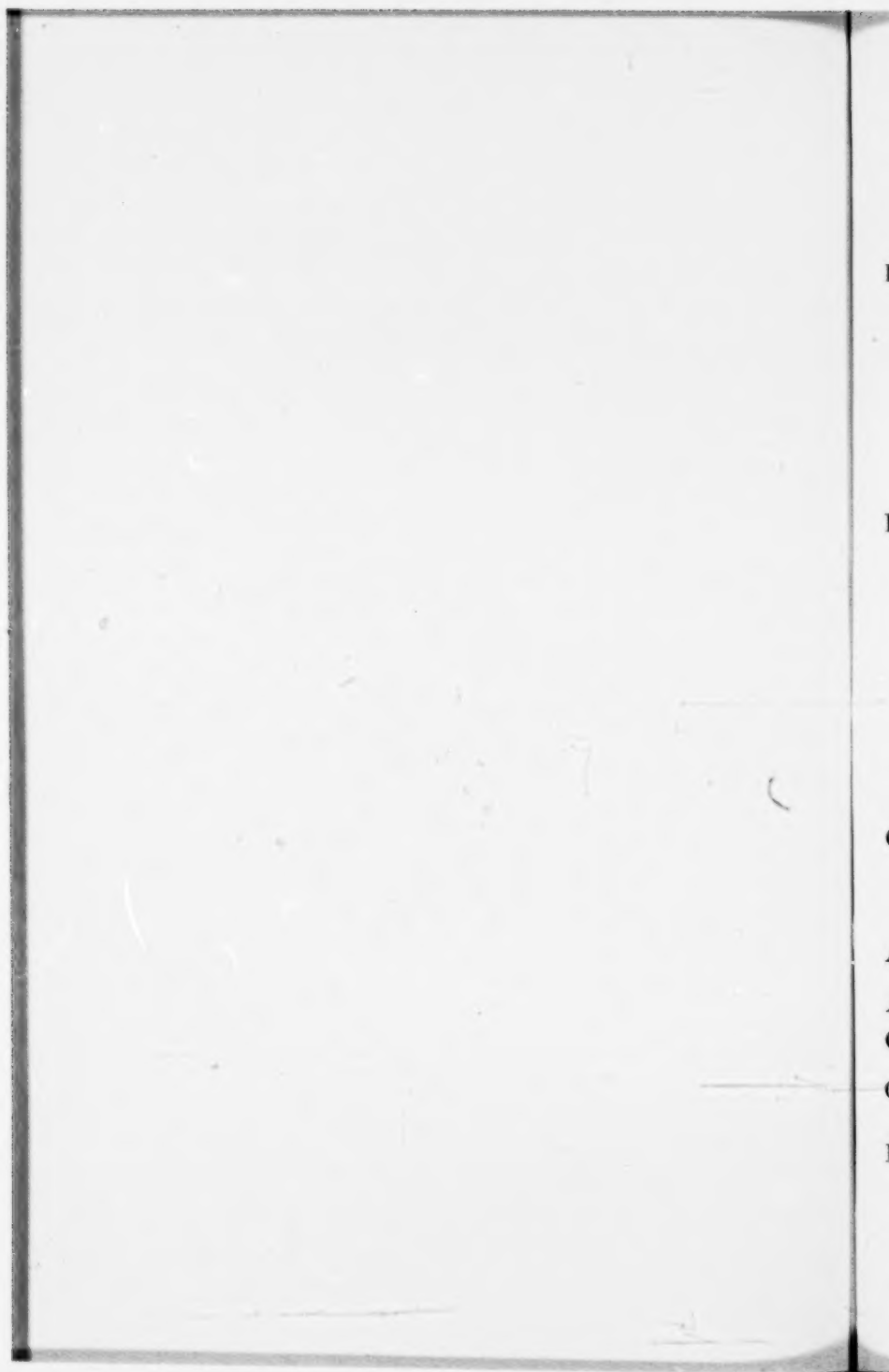
HORN SIGNAL MANUFACTURING CORPORATION,
Petitioner,

v.

DAVID KATZ,
Respondent.

**PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE SECOND CIRCUIT AND BRIEF
IN SUPPORT THEREOF**

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INDEX

	PAGE
Petition for Writ of Certiorari to the United States Circuit Court of Appeals for the Second Circuit	1
Summary Statement of the Matter Involved	1
Jurisdiction	5
Questions Presented	5
Reasons Relied Upon for the Granting of the Writ	6
Brief in Support of Petition	9
Opinions of the Courts Below	9
Statement of the Case	9
Specification of Errors	10
Summary of Argument	11
Point I.	11
Point II.	14
Point III.	19
Conclusion	20

TABLE OF CASES

Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U. S. 477, 487	5, 20
Atlantic Works v. Brady, 107 U. S. 192, 200	5, 6
Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403	4, 14
Cuno Engineering Corp. v. Automatic Devices Corp., 314 U. S. 84, 91	5, 6
Diamond Rubber Co. v. Consolidated Tire Co., 220 U. S. 428	4, 6, 7, 10, 18

Dow Chemical Co. v. Halliburton Oil Well Cementing Co. (decided Mar. 5, 1945)	19
Hogg v. Emerson, 11 How. 587	4, 14
Hotchkiss v. Greenwood, 11 How. 264, 267	5
Paramount Publix Corp. v. American Tri-Ergon Corp., 294 U. S. 464	20
Schriber-Schroth Co. v. Cleveland Trust Co., 311 U. S. 211	4, 14, 20
Smith v. Snow, 294 U. S. 1	4, 14

PUBLICATION

Electricity and Magnetism by Guillemin, McMillan & Co., New York, 1891, pp. 378-80	2
---	---

STATUTES

United States Judicial Code, Section 24(7), (28 USC, Sec. 41)	5
United States Judicial Code, Section 240(a), 28 USC 347)	5

RULES OF CIVIL PROCEDURE

Rule 52(a)	4, 6
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**PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE SECOND CIRCUIT**

*To the Honorable the Chief Justice and Associate Justices
of the Supreme Court of the United States:*

Your petitioner, Horni Signal Manufacturing Corporation, respectfully prays for a writ of certiorari to the Circuit Court of Appeals for the Second Circuit, to review a decree of that court dated February 9, 1945 (R. 220). A certified transcript of the record in the case, including the proceedings in said Circuit Court of Appeals is furnished herewith in accordance with Rule 38 of this Court.

Summary Statement of the Matter Involved

The complaint was filed in this case by the respondent David Katz, charging infringement by the petitioner of United States Letters patent 1,992,214 issued to respond-

ent on February 25, 1935 (R. 2-3). An answer was filed by the petitioner denying infringement, asserting invalidity of the patent and setting up other defenses (R. 4-7).

The case was tried in the District Court for the Southern District of New York (Leibell, J.), resulting in the entry of a final judgment dismissing the complaint on the merits (R. 193). Respondent appealed and the Second Circuit Court of Appeals, in an opinion by Judge Frank dated November 15, 1944 and amended December 20, 1944, reversed the District Court and held the patent valid and infringed (R. 200-5).

The patent in suit relates to a detector for traffic signals. It is used in connection with the so-called "vehicle-actuated" signal in which the conventional crossing signal is changed from red to green by the approaching vehicle. It consists of nothing but a coil of wire placed near the roadway adjacent the intersection and in the path of the vehicle. The vehicle, being principally iron, induces an electric current in the coil and this current, through instrumentalities which form no part of the present invention, causes the signal light to change from green to red. There is nothing alleged to be new in the principle on which the device operates. It was old and well known many years prior to respondent's invention that relative movement of a magnet and a coil would create an electric current in the coil. It is the ancient Faraday law which is described in every standard text book on physics.*

Respondent's expert described the invention as follows (R. 22):

"This invention deals with traffic detectors. The subject matter described here in this patent is relatively simple so far as the technical aspects are concerned. A coil is embedded in the ground or placed

* Electricity and Magnetism by Guillemain, McMillan & Co., New York, 1891, pp. 378-80.

in proximity to a roadway, and a car passing in the vicinity causes electric current to be induced in the coil, and these coils, in turn, are used for operating a traffic light or a number of other devices mentioned in the first portion of the specification."

In a further description of the principle of operation he stated (R. 24-25):

"Now, the patent in suit mentions the Faraday principle. Now, this principle deals with the induction of current in electric conductors by means of magnetic fields. Faraday discovered that when a permanent magnet, as I have just described, is approached by a coil, or if the magnet is moved from a coil, an electric current occurs in that coil. We call that principle the principle of induction, and the principle involved in the subject matter of this suit utilizes this same phenomenon."

The disclosure of the patent in suit is specific in two respects. Whereas most devices which function by the induction of a current in a coil depend upon movement of a magnet, and its magnetic field, with respect to the coil, respondent alleged that the induction of a current in the coil of his device results from disturbance of the earth's magnetic field by the passage of the iron body of the vehicle. Thus instead of creating a current by the movement of a magnetic field with respect to the coil, respondent alleges that the lines of force of the earth's magnetic field, which are always present in any locality, are distorted by the passage of the vehicle and that this distortion causes induction of the current in the coil.

The second respect in which the disclosure of the patent is specific is that the respondent uses a large coil extending approximately half way across the road to be certain that it will be straddled by the vehicle as the vehicle approaches the intersection. The District Judge summarized

the disclosure as follows (R. 176):

“The patent specification taught only the use of a rectangular coil of large size and the various positions in which it could be placed—in, under, over or alongside the road.”

The device charged to infringe consists of a compact coil having an outside diameter of approximately $\frac{3}{4}$ ", approximately $6\frac{3}{4}$ " in length, with a core of five strips of "Mumetal" (R. 151). This device is placed beneath the roadway and relies upon the residual magnetism in the body of the vehicle to induce a current in it, just as in the classic Faraday experiment, as the vehicle passes over the coil (R. 63).

The Court of Appeals, in finding the patent infringed by petitioner's construction, disregarded the well established rule that the claims of a patent are to be read and interpreted in the light of the specification (*Hogg v. Emerson*, 11 How. 587; *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403; *Smith v. Snow*, 294 U. S. 1; *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U. S. 211).

The Court of Appeals also failed to conform to Rule 52(a) Rules of Civil Procedure in setting aside the findings of the trial judge. He held (Findings 28, 29, R. 191) that the claims in suit were not infringed and there was substantial evidence in support of these findings.

The Court also disregarded limitations in the claims that the production of a current in the coil results from the disturbance of the earth's magnetic field. In doing so, the Court incorrectly applied the doctrine of *Diamond Rubber Co. v. Consolidated Tire Co.*, 220 U. S. 428, that it is immaterial whether the patentee correctly understands how his device operates.

The Court of Appeals, in holding the patent valid, also departed from established practice in not concluding that

the patentee had exercised merely the skill of the calling rather than the display of inventive genius. *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 91; *Altoona Public Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477, 486; *Atlantic Works v. Brady*, 107 U. S. 192, 200; *Hotchkiss v. Greenwood*, 11 How. 248, 264, 267.

Every *claimed* element of the patent in suit is disclosed in closely analogous prior art and every student of high school physics knows that movement of a magnet with respect to a coil will produce a current in the coil. The statement of the Court of Appeals that respondent's achievement is "a real invention unanticipated and commercially successful which satisfy the strictest standard employed by the Supreme Court" (R. 204) is clearly erroneous.

Jurisdiction

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by the Act of February 13, 1925 (28 U. S. C., Section 347).

This is a suit arising under the patent laws of the United States, Judicial Code, Section 24(7) (28 U. S. C., Section 41).

The date of the judgment which petitioner seeks to have reviewed is February 9, 1945 (R. 220).

Questions Presented

1. Is a patent which discloses but one form of coil, a *large* rectangular loop covering one-half of the roadway, entitled to an interpretation which includes the small, totally different type of coil used by the petitioner;

(a) When the respondent disclaimed coils below a certain size by an affidavit filed during the prosecution of the application?

(b) When the trial judge, on the basis of such evidence, found that the patent is not infringed, is the Court of Appeals justified, in the light of rule 52(a) of the Rules of Civil Procedure, in not adopting such finding?

2. Whether or not a patentee who obtains a patent by asserting a method of operation, alleged to be different from that of a prior art patent, which method of operation is incorporated into the claims of the patent, can abandon it after the grant of the patent and rely upon the doctrine of this Court in the case of *Diamond Rubber Co. v. Consolidated Tire Co.*, 220 U. S. 428, to support his changed position?

3. Did the Court of Appeals properly apply the doctrine of this Court in *Atlantic Works v. Brady*, 107 U. S. 192 and *Cuno Engineering Corp. v. Automatic Devices*, 314 U. S. 84, when it disregarded prior art references showing the same construction in closely related arts?

4. Is the patentee entitled to broad patent protection on a traffic detector for automotive traffic, which is old, *per se*, in the railroad art merely because the body of an automobile contains sufficient residual magnetism to induce a current of sufficient strength in a coil to operate sensitive relays that were available at the time his application was filed?

Reasons Relied Upon for the Granting of the Writ

1. The Court of Appeals departed from established practice and failed to comply with the provisions of Rule 52(a) of the Rules of Civil Procedure in holding the claims of the patent in suit infringed by the totally different detector coil of the petitioner.

(a) In not accepting the findings of the trial judge based on the disclosure of the patent itself and the disclaimer contained in respondent's affidavit.

(b) In not applying the well established doctrine that the claims of a patent must be interpreted in the light of the specification on which they are based.

2. There is a direct conflict between the holding of the Court of Appeals that the patent here in suit is valid and the doctrine that the exercise of inventive genius is necessary to support the grant of a patent.

(a) In reaching its erroneous conclusion, the Court of Appeals incorrectly applied the doctrine of *Diamond Rubber Tire Co. v. Consolidated Tire Co.*, *supra*.

3. Petitioner and respondent's licensee both have places of business located in the Second Circuit (R. 2 and 142) and are the only manufacturers of vehicle actuated traffic signals in this country. There is thus little likelihood of litigation arising in another circuit whereby conflict might occur as a basis for a petition to this Court.

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IN THE
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OCTOBER TERM, 1944

No.

HORN SIGNAL MANUFACTURING CORPORATION,

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DAVID KATZ,

Respondent.

BRIEF IN SUPPORT OF PETITION

Opinions of the Courts Below

The opinion of the District Court for the Southern District of New York appears at pages 155 to 185 of the record and is reported in 52 F. Supp. 453. The opinion of the Second Circuit Court of Appeals appears at pages 200 to 205 of the record and is reported in 145 F. (2d) 961.

Statement of the Case

The foregoing petition contains a statement of the material facts as well as the questions presented by the petition.

Specification of Errors

1. The Second Circuit Court of Appeals erred in holdings claims 7 and 11 of the Katz patent 1,992,214 to be valid and infringed.

2. The Court of Appeals of the Second Circuit erred in holding that a patent whose entire disclosure is directed to a large open coil without a core and in which the file wrapper contains a statement under oath by the patentee disclaiming any coil smaller than a certain size can be interpreted to cover a small, compact coil of a size disclaimed by the patentee, regardless of the language of the claims.

3. The Second Circuit Court of Appeals erred in finding that "plaintiff has achieved a real invention, unanticipated and commercially successful," disregarding prior art references in closely related arts disclosing every *claimed** element of the patent.

4. The Second Circuit Court of Appeals incorrectly applied the doctrine of *Diamond Rubber Co. v. Consolidated Tire Co.*, 220 U. S. 428, in holding that the method of operation disclosed in the Katz patent and incorporated into the claims during the prosecution of the application to avoid anticipation by prior art patents is not binding on the patentee.

5. The Second Circuit Court of Appeals erred in holding that the use of an old and known construction for an alleged new purpose which eliminated the necessity of one element of the co-operating *unclaimed* structure of a prior art patent is an invention under the patent statutes.

* Emphasis ours throughout, unless otherwise indicated.

Summary of Argument

The points of the argument follow the reasons relied upon for the granting of the writ.

I.

The entire disclosure of the patent in suit is directed to a large, open coil of a size approximating *one-half the width of a roadway*. Regardless of the language of the claims, the Court of Appeals erred in interpreting the patent to read upon a coil having a diameter of approximately $\frac{3}{4}$ ", approximately $6\frac{3}{4}$ " in length (Exh. E, R. 151).

The patent drawings contain 18 figures and in every instance where the coil is illustrated in connection with a roadway, it is of a width equal to substantially one-half the width of the road. On page 3, column 1, lines 71-74 it is stated that *the transverse legs extend half way across the road*. In line 3 of column 2 of page 3 it is stated that the distance between *the transverse legs varies from 5 to 12 feet*. In the sentence beginning in line 26 of the second column of page 3 it is stated that the transverse legs may extend *more than half way across the road*.*

In addition, the patentee specifically disclaimed coils of the type employed by the petitioner. On July 1, 1933, he filed an affidavit, sworn to August 31, 1928 (Exh. B, pp. 121-29). That affidavit (p. 127), discussing a coil

* By stipulation (R. 197) the documentary exhibits were not printed in the Court of Appeals but were certified as physical exhibits. They are being certified here as physical exhibits by the Clerk of the Court of Appeals. References in this petition are therefore to pages of the actual exhibits. Copies of the patent in suit, the Edison patent 470,923 and the Clark patent 541,719 are being filed as an appendix to this petition.

2½ x 1½ feet, stated:

“The failure of the system to operate with speeds of 30 miles an hour or higher is obviously due to the fact that the two legs of the coil which run crosswise of the road *were too close together for such high speeds.*”

It further stated (p. 128) that at a speed of 25 miles per hour the transverse legs of the coil *must be 5 feet apart* and at speeds up to 50 miles an hour, the cross running legs of the loop should be *10 to 15 feet apart*.

It is of course true that a patent may disclose an element of a certain size or character and not be limited to the disclosure. But here the respondent sets forth a method of operation alleged to differ from the method of operation of the devices of prior art patents operating on the same principle and the use of a large coil is an essential feature of such method. On the basis of such disclosure, and the disclaiming affidavit of respondent, there was substantial evidence in support of the trial judge's finding of non-infringement. When such evidence exists, it is not the duty of the Court of Appeals to consider the case de novo and decide whether it would reach the same conclusion that the trial judge reached. The only duty of the Court of Appeals is to determine whether or not substantial evidence exists to support the finding and if it does, the Court of Appeals should affirm.

In considering this question, the District Judge stated (R. 176):

“*The patent specifications taught only the use of a rectangular coil of large size and the various positions in which it could be placed—in, under, over or alongside the road. The distance between the legs of the rectangular coil seemed to be important to the applicant, for the reason that he got a direct*

E. M. F. induced in the transverse leg nearer the passing automobile and a reverse E. M. F. induced in the other parallel leg. His purpose seems to have been to get as little reverse E. M. F. in one of the legs as possible in comparison with the direct E.M.F. in the other, and not to have the reverse E. M. F. occur 'simultaneously with the direct E. M. F.'. Referring to the rectangular coil of Fig. 6 the specifications state: 'In practical tests I have obtained satisfactory results with coils of this type from 50 to 100 turns, and with a distance between the transverse *legs varying from 5 to 12 feet.*' This same problem of the direct and reverse E. M. F. induced in opposite legs of the rectangular coil or loop, is referred to in the description of Figs. 7, 15 and 16."*

Even if it is proper for an Appellate Court to review the evidence in detail and reach its own conclusion on the question of infringement, we submit that the Second Circuit Court of Appeals erred in this instance. The teaching of the patent is that the coil must be large enough to be straddled by the vehicle to distort that portion of the earth's field which passes through the coil. Regardless of the language of the claims, the disclosure of the patent, together with the asserted method of operation and the limitation by affidavit to coils larger than a 5 foot rectangle requires limitation of the claims to a large coil of the type shown in the patent.

The Court of Appeals disposed of this defense by resorting to the claim language read out of the context of the specification and by disregarding the respondent's disclaimer, the court stated:

"But two of the claims not in suit specifically speak of a 'coil in the form of a large loop area' while neither claims 7 nor 11 contains such restrictive language" (R. 204).

*(See also Findings 8, 28, 29, R. 188 and 191.)

Whether or not claims 7 and 11 contain restrictive language, the claims must be read in the light of the specification and when so read, properly embrace *only* the type of coil shown in the patent (*Hogg v. Emerson* 11 How. 587; *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403; *Smith v. Snow*, 294 U. S. 1; *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U. S. 211).

II.

Having given the patent in suit an interpretation that covers the use of any coil, large or small, and the creation of an electric current in such coil by the mere passage of a vehicle, whether due to residual magnetism in the body of the car, to distortion of the earth's field, or to any other cause, the Court of Appeals failed to apply the accepted tests of invention when it stated:

"plaintiff has achieved a real invention, unanticipated and commercially successful, which satisfied the strictest standard employed by the Supreme Court" (R. 204).

Respondent presented a claim to the Patent Office during the prosecution of his application, which claim was of the scope that the court now gives to claims 7 and 11. This claim reads as follows (Exh. B. p. 14):

"12. A device for detecting the motion of highway traffic, comprising a coil of wire situated in proximity to the path of the traffic and having its terminals connected to an electrical apparatus adapted to respond to weak induced currents."

Upon rejection, this claim was cancelled and the present claims were presented, limited to operation of the device by distortion of the earth's field. The rejection of claim 12 on the prior art, as exemplified by the Edison patent and the Clark patent, was sound. The Edison patent discloses a railway signal in which a coil is placed be-

tween the rails and the coil connected by suitable wiring to a signal mounted on a pole beside the track. There is no source of current provided in the coil circuit. A current is induced in the coil by a magnet carried on the engine when the train passes over the coil.

The Clark patent is directed to a burglar alarm and discloses a coil connected to a signal and adapted to be actuated by the current induced in the coil when a burglar and his bag of iron tools passes over the coil.

To avoid these references, respondent presented claims of the type appearing in the patent. Claim 7, a dependent claim, must be read with claim 1:

"1. In combination with a roadway designed for automobile type traffic, an indicator; an electric circuit; a conductor in said circuit, said conductor being situated in proximity to the path of the traffic and in position to be traversed by the disturbance of the earth's magnetic field normally attending the passage of an automobile over the roadway with a resultant induction of an electromotive force in said circuit; and means responsive to said electromotive force to operate said indicator."

Claim 7 reads as follows:

"7. A combination as in claim 1, said circuit containing no sources of electrical energy."

The italicized portion of claim 1 is the portion added to overcome rejection in the Patent Office. That it was effective in obtaining the allowance of the claims is apparent from the language appearing in the decision of the Board of Appeals which reads as follows:

"The patent to Edison discloses a coil embedded between the rails of a railway track and connected through an electromagnet designed to operate a signal. For inducing a current in the coil, Edison proposed to subject its core, presumably a non-mag-

netic one, to the action of a magnet on a passing car so disposed as to pass in close proximity to the core" Exh. B, pp. 185-186).

The Board then proceeded to allow claims 51, 52 and 53 (claims 10, 11 and 12 of the patent in suit) but affirmed the rejection of claims 48 and 49 (Exh. B, p. 187). Claim 48 (Exh. B, p. 69) is also substantially of the scope now accorded claims 7 and 11 by the decision of the Court of Appeals. That claim reads as follows:

"A device for the automatic actuation of an electrical apparatus in response to the passage of a vehicle of the automobile type through a given zone or region comprising an electrical circuit adapted to transform transient changes in the magnetic field in said zone or region into corresponding transient electrical currents in said circuit, said circuit being in continuous readiness to respond to such transient changes in said magnetic field without continuous consumption of energy."

It is clear error to interpret the claims accepted by the patentee as of a scope equal to, or greater than, that of cancelled claims 12 and 48.

The reasoning of the Court of Appeals in reaching the conclusion that the claims are valid, is not clear. The opinion merely states that it agrees with the trial judge on validity. The Court presumably gave the italicized portion of the claim full force and effect in finding the claim valid, but then totally disregarded this portion of the claim to find it infringed. If the italicized portion of the claim is disregarded, every element thereof is found in the Edison patent. The only difference between the claim and the Clark patent is that Clark provides a source of current. That is not a patentable difference.

But the Court disregarded the italicized portion of the claim on the question of infringement and thus interpreted the claims to include Edison's device and Clark's device.

If it makes no difference how or why the device operates, then it does not differ from Edison or Clark. If respondent made any discovery it was that the residual magnetism in the body of an automobile would function in the place of the magnet of Edison, but that cannot be invention and that is not claimed. The District Court disposed of the Edison patent on that ground (R. 164) as did the Patent Office Board of Appeals, *supra*, p. 15. But the Courts had before them the evidence that petitioner's device operates due to residual magnetism in the body of the car *which the Patent Office did not have*. On the record as presented in this case, the presence of sufficient residual magnetism in the body of the car is the only discovery made by the respondent. The claims, however, are not directed to this discovery but, as interpreted, are of a scope equal to cancelled claim 12 (*supra*, p. 14).

While the respondent convinced the Patent Office of the patentability of his claims by asserting that the operation of the device differed from the operation of the prior art patents because it relies upon distortion of the earth's magnetic field, no attempt was made to establish that petitioner's device so operates. Knowing that he would have to admit that the residual magnetism of the body of the automobile causes the creation of a current in the coil, respondent's expert testified that the two phenomena operate together but freely admitted that residual magnetism is present in the body of a car and produces an electric current in the coil. On this question he stated (R. 28-29):

"The metal used in automobiles can be magnetized to a considerable extent compared with the material we are using in electrical machines. The motor, for instance, consists of cast steel, but cast iron is also used. That is, the metal is of relatively low grade with respect to permeability or magnetism. *Consequently the car represents a magnet or, perhaps, a group of structurally connected little and smaller magnets. Consequently there must be a field of force accompanying the automobile.*

I have illustrated this component of the magnetic distortion in Fig. 6 of Exhibit 9. The lines of force I have illustrated are arbitrary, because each car has its own field. The field is distorted and highly irregular. The car may have one pole at the front and one at the end, but there may be different poles, and the particular shape of this magnetic field is of no concern, because it is certain that the passage of such a field of any shape in the vicinity of the coil must effect a change of the magnetic field effective in the coil. Consequently this phenomenon also can produce an electric current in the coil."

The Court of Appeals having presumably concluded that the patent is valid because the claims refer to distortion of the earth's magnetic field, then had to ignore this limitation to conclude that the claims were infringed. It did so by relying upon the doctrine of *Diamond Rubber Co. v. Consolidated Tire Co.*, *supra*, and stated (R. 205):

"Defendant argues that the statement in the claim that the induction results from 'the disturbance of the earth's magnetic field normally attending the passage of an automobile' is not correct; that what actuates the coil is the 'residual magnetism' in the automobile. *But it is immaterial whether patentee correctly understands how his device operates; Diamond Rubber Co. v. Consolidated Tire Co.*, 220 U. S. 428, 435-436; *Proctor & Gamble Co. v. Berlin Mills Co.*, 256 F. 23, 28 (C. C. A. 2, reversed on other grounds in 254 U. S. 156)."

The doctrine of the *Diamond Tire* case, however, was never intended to mean that a limitation placed in a claim for the purpose of obtaining the allowance of the claim could be disavowed at a later date. Misinterpretation of this doctrine is a matter of general interest and should be considered by this Court. The *Diamond Tire* case has been cited with approval about as frequently as any case dealing with patents. It expresses a very salutary doctrine when properly applied. The misapplication of the rule to situa-

tions where it does not apply, as in the present case, tends to bring the doctrine into disrepute.

In the present case, there is not only the disavowal of the limitation to support the holding of infringement. There is also the necessity of relying upon it to escape invalidity.

If the error of the Court of Appeals in the application of this doctrine is corrected, we are presented with the simple question whether there is any invention in bodily transferring the device of Edison operated by a magnet on the train or the device of Clark operated by residual magnetism in the iron of the burglar's tool to automobile traffic, and operating it by the residual magnetism in the body of the car. It is a clear case of the new use of an old device, and the question was answered in the negative by this Court as recently as March 5, 1945 in the case of *Dow Chemical Co. v. Halliburton Oil Well Cementing Co.*

III.

The improbability of litigation involving the patent in suit in any other circuit and the improbability of conflict thus being created is another reason why this writ should be granted. While petitioner is a New Jersey corporation, it has a place of business in New York City (R. 2) and was sued in the Southern District of New York. Respondent's licensee is a Delaware corporation having a place of business at East Norwalk, Connecticut (R. 142), also in the Second Circuit. Even if the licensee should cancel its license, which is highly improbable as long as the present decision stands, it could be sued in the Second Circuit because of the location of its place of business. These two companies are the only manufacturers of vehicle actuated traffic signals.

This Court has granted petitions for certiorari on the ground that the validity of a patent is a matter of public interest and there was little likelihood of litigation of the

patent in another circuit. *Paramount Public Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464; *Altoona Public Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477; *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47. The patent here in suit involves a question of public interest. The apparatus forming a part of a traffic signal is purchased by municipalities, counties and state highway commissions. It is paid for by taxes and if a royalty is paid, every member of a community which purchases one or more of the devices pays his proportionate share of the tribute. The reason for granting the writ in the cases cited above is therefore particularly applicable to the present case.

Conclusion

It is urged, therefore, that the petition for certiorari be granted.

Respectfully submitted,

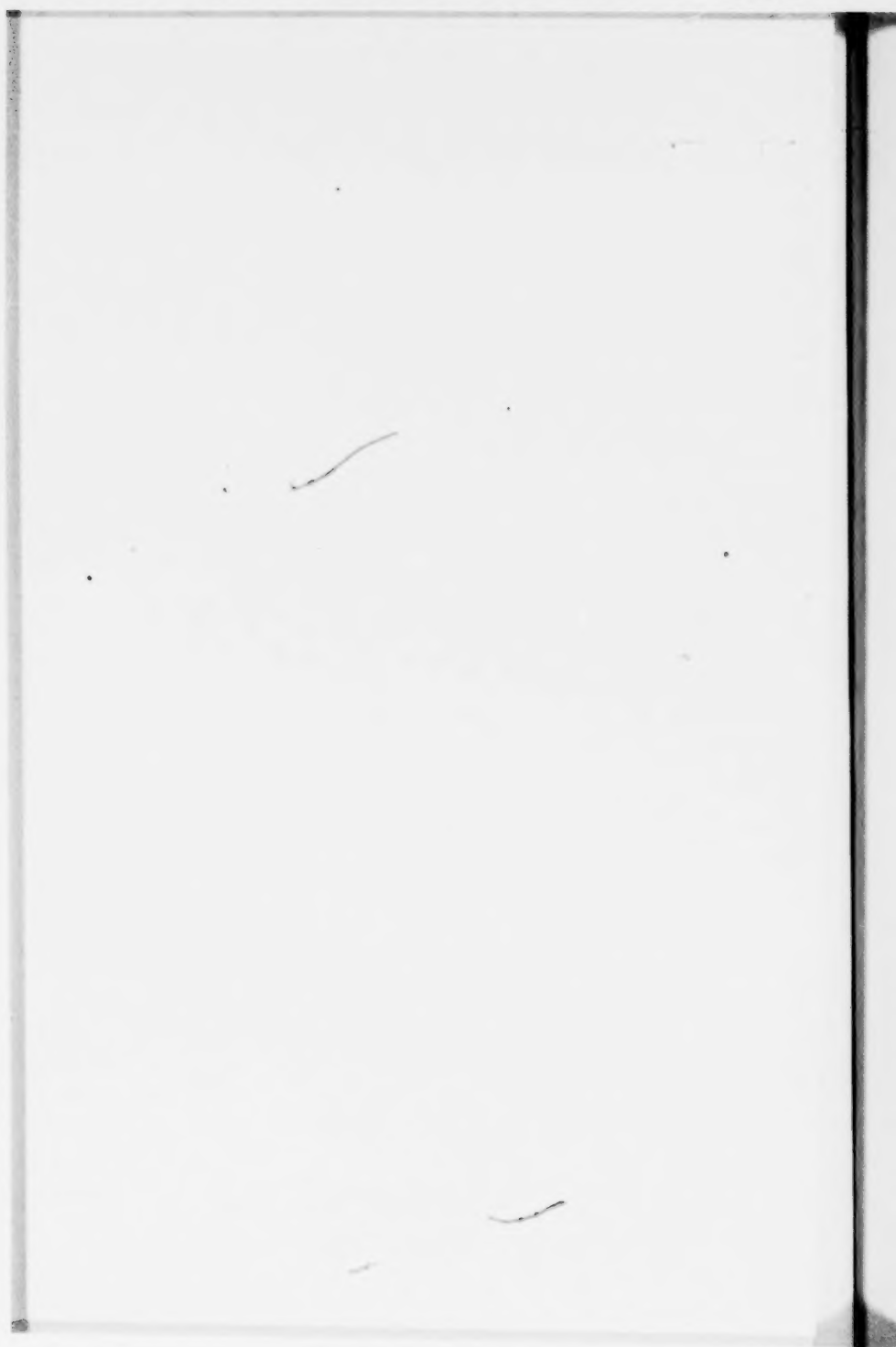
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In the
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October Term, 1944

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HORNI SIGNAL MANUFACTURING COMPANY,

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**BRIEF IN OPPOSITION TO PETITION FOR WRIT OF
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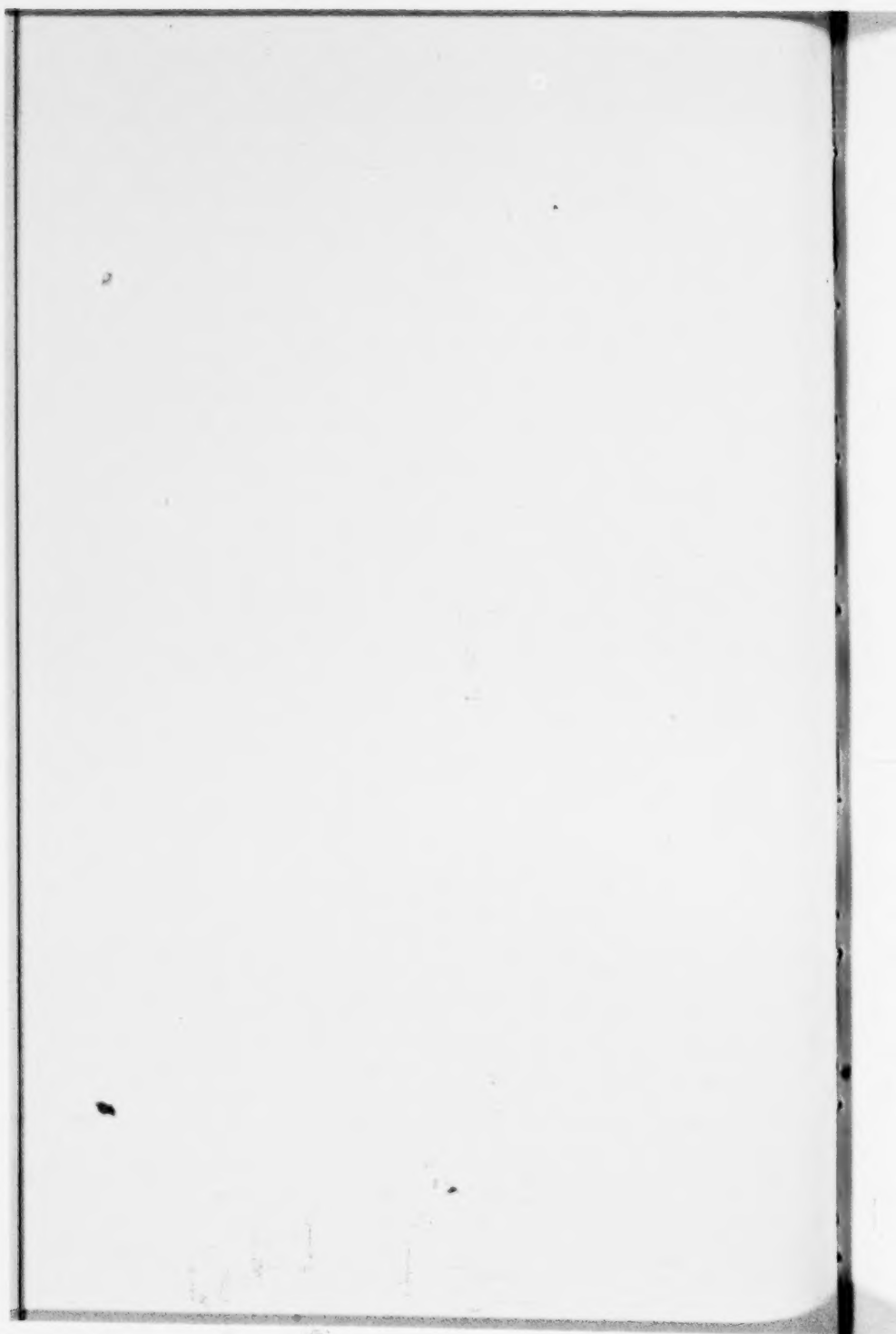
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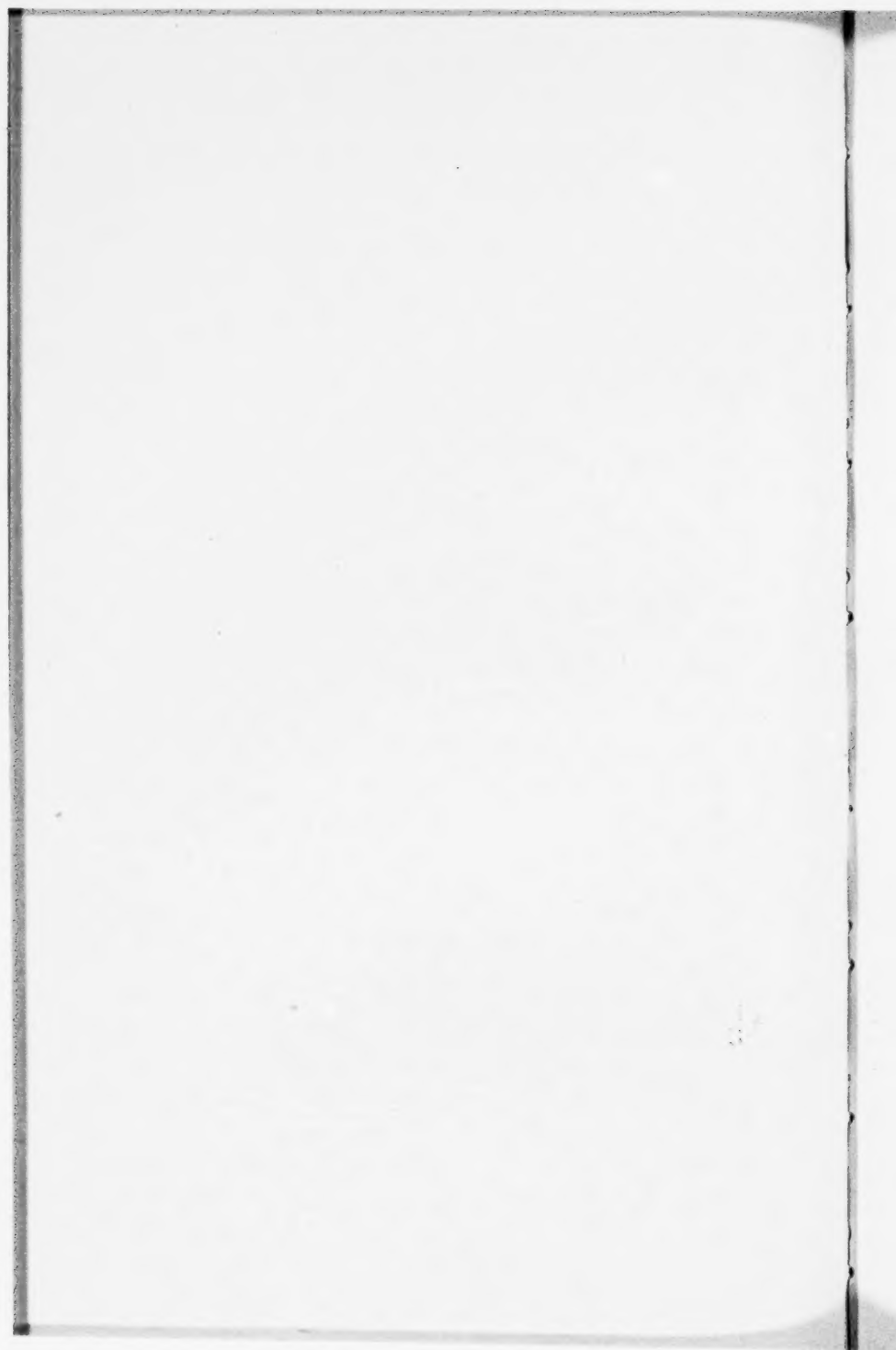
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	PAGE
Brown v. Kriemeyer, 275 U. S. 496 (1927)	6
Diamond Rubber Tire Co. v. Consolidated Tire Co., 220 U. S. 428 (1911)	3
Engineering & Research Corp. v. Horni Signal Corp., 90 F. (2nd) 682; 39 U. S. P. Q. 1 (C. C. A. 2, 1938)	5
Humble Oil & Refining Co. v. Campbell, 292 U. S. 648 (1934)	6
Kunglig Järnvägsstyrelsen v. National City Bank, 275 U. S. 497 (1927)	6
Magnum Import Co. v. Coty, 262 U. S. 159, 163 (1923)	3
Milwaukee v. Activated Sludge, Inc., 293 U. S. 576 (1935)	5
Rule 38 Supreme Court Rules	6
Rule 52 (a) Civil Procedure	2, 3
Tiger v. Lozier, 275 U. S. 496 (1927)	6



In the
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1944.

No. 1067

HORNI SIGNAL MANUFACTURING COMPANY,

Petitioner,

vs.

DAVID KATZ, *Respondent.*

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF
CERTIORARI TO THE UNITED STATES
CIRCUIT COURT OF APPEALS FOR
THE SECOND CIRCUIT

*To The Honorable Chief Justice And Associate Justices of
the Supreme Court:*

Your Respondent, David Katz, respectfully prays that the petition for writ of certiorari be denied.

This is an ordinary patent case involving no important or novel question of law. There is admittedly no conflict of decisions between Circuits Courts of Appeal, and there are no circumstances peculiarly affecting the public interest.

Petitioner is apparently seeking to create the impression that there is a conflict of decisions. On page 7 of the petition, it is stated that there is a direct conflict between the holding that the patent in suit is valid and the doctrine that the exercise of inventive genius is necessary to support the grant of a patent.

This statement will not bear scrutiny. It is unmistakably clear from the record that the device of the patent involved the exercise of inventive genius, and both the District and Circuit Courts so held (R. 204).

Petitioner is also apparently seeking to create the impression that the Circuit Court of Appeals has overturned well-settled legal principles.

On page 6 of the petition, it is stated that the Circuit Court failed to comply with the provisions of Rule 52 (a) of the Rules of Civil Procedure. Petitioner has reference to the following language of the rule:

" * * * Findings of fact shall not be set aside unless clearly erroneous * * * "

The District Judge held that the device of the patent involved the exercise of inventive genius, and that it was a primary invention without any prior art to limit the scope of the patent (R. 168, fol. 504). The Circuit Court sustained these findings, *because they were clearly correct* (R. 204).

The District Court held the claims in suit not infringed. The Circuit Court reversed this finding, *because it was clearly erroneous and inconsistent with the holding that the invention was a primary one without any prior art to restrict the scope of the patent.*

It follows that Petitioner's contention that the Circuit Court failed to comply with Rule 52 (a) is untenable.

On page 7 of the petition, it is stated that the Circuit Court failed to apply the well-established doctrine that claims of a patent must be interpreted in the light of the specification. Petitioner further states that the Circuit Court incorrectly applied the doctrine of *Diamond Rubber Tire Co. v. Consolidated Tire Co.*, 220 U. S. 428 (1911).

Even a cursory reading of the opinion clearly indicates that these contentions are untenable.

It is important to note that the decision of the Circuit Court holding the patent valid and infringed was by a *unanimous* Court, and that the opinion was written by Judge Frank, whose strict views on the subject of patent validity and infringement have found expression in many decisions of the Second Circuit.

It may be noted in passing that Petitioner's arguments in support of its contentions are largely those which were presented first to the District Court and then to the Circuit Court of Appeals. Petitioner admittedly had ample opportunity to present his case in the District Court and in the Circuit Court of Appeals. As was held in *Magnum Import Co. v. Coty*, 262 U. S. 159, 163 (1923), this Court's jurisdiction was not conferred merely to give the defeated party in the Circuit Court another hearing.

Realizing that it has no case for certiorari, Petitioner seeks to build a case by making the *unverified and unsupported* statement that Petitioner and Respondent's licensee are the only manufacturers of vehicle-actuated traffic signals in this country.

Since this statement is unverified and has no support in the record, it requires no answer. However, Respondent takes this opportunity to state that there are a number of manufacturers and distributors of traffic signals of various types in the United States in addition to Petitioner and Respondent's licensee, the Automatic Signal Corporation.

Hayes Electric Mfg. Co. of Lansing, Michigan, and Pioneer Sales Corp. of Detroit, Michigan (Sixth Circuit) have manufactured and distributed vehicle-actuated traffic signals, *which are of substantially the same construction as the devices made by Petitioner.*

The Eagle Signal Corporation of Moline, Illinois (Seventh Circuit) is distributing vehicle-actuated traffic signals as a sub-licensee of the Automatic Signal Corporation.

The Gamewell Company, which is incorporated in Massachusetts (First Circuit), manufactures and distributes signalling devices of various kinds. It owns Durbin Patent No. 2,051,369 for a vehicle-actuated traffic signalling system.

The General Electric Co. and Crouse-Hinds Co. have main offices in the Second Circuit, but do business in traffic signals throughout this country. The General Electric Co. owns Peterson Patent No. 1,965,430 for a vehicle actuated traffic signal.

The Westinghouse Electric & Mfg. Co., which is incorporated under the laws of Pennsylvania (Third Circuit), manufactures and distributes traffic signalling devices throughout the United States.

The Signal Service Corp. of Elizabeth, New Jersey (Third Circuit) is another company in the traffic signalling system business.

On page 20 of its brief, Petitioner alleges that the patent in suit involves a matter of public concern, because traffic signals are bought by governmental agencies, and hence every member of the community pays his proportionate share of the royalty through taxation.

It is certainly stretching the imagination to the breaking point to argue that a patent involves a question of public interest, merely because the device may sometimes be purchased by or on behalf of a governmental agency. Most patented articles are purchased directly by the public, and the purchase price, a substantial part of which is the royalty, comes directly out of the pocket of the purchaser. In the case of articles purchased by or on behalf of the government, the purchase price comes only indirectly from the members of the public, and each member's proportionate share of the royalty is so small as to be negligible.

Furthermore, both Petitioner and others are manufacturing other types of vehicle-actuated traffic signalling devices, and the public has a right to use these other types without paying any royalty at all to the patentee. As an example of a type of device, which may be used by the public without the payment of royalty, may be mentioned the vehicle-actuated signal which was involved in *Engineering & Research Corp. v. Horni Signal Corp.*, 90 F. (2d) 682; 39 U. S. P. Q. 1 (C. C. A. 2, 1938).

In any event, certiorari has been denied in a number of cases in which the public interest was far greater than in the case at bar. See, for instance, *Milwaukee v. Activated Sludge, Inc.*, 293 U. S. 576 (1935).

We respectfully submit that Petitioner has failed to make out a case warranting the grant of the writ of certiorari. Furthermore, we respectfully submit that the petition should

be denied for the additional reason that the brief violates Rule 38 of this Court, requiring that the brief be direct and concise. The greater part of the brief, instead of being directed to the merits of the petition, constitutes a reargument of the issues of validity and infringement. Such matter is clearly improper in a petition.

Cases in point are:

Tiger v. Lozier, 275 U. S. 496 (1927)

Brown v. Kriemeyer, 275 U. S. 496 (1927)

Kunglig Järnvägsstyrelsen v. National City Bank,
275 U. S. 497 (1927)

Humble Oil & Refining Co. v. Campbell, 292 U. S.
648 (1934).

Respectfully submitted,

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HENRY L. BURKITT,
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CHARLES ELMORE OROPLEY
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IN THE
Supreme Court of the United States

OCTOBER TERM, 1944

No. 1067

HORN SIGNAL MANUFACTURING COMPANY,

Petitioner,

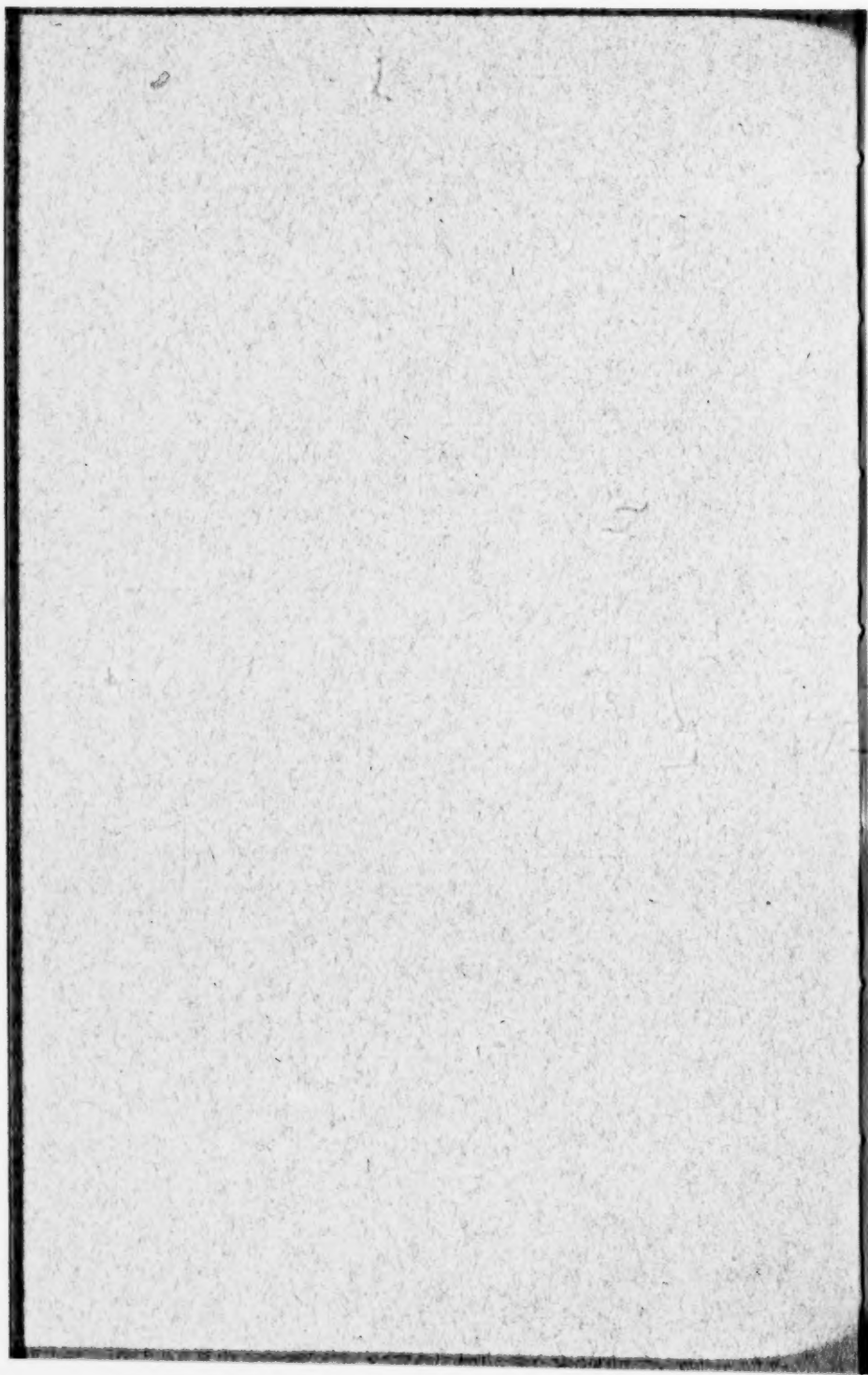
v.

DAVID KATZ,

Respondent.

PETITIONER'S REPLY BRIEF

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— ♦ —

PETITIONER'S REPLY BRIEF

There is only one point raised in respondent's brief to which we wish to reply, that is, the discussion of the third reason relied upon for the granting of the writ (Respondent's brief, p. 4).

The third reason for the granting of the writ is that petitioner and respondent are the only manufacturers of *vehicle actuated traffic signals* and that litigation involving the patent in any other circuit is therefore improbable. On page 4 of respondent's brief reference is made to eight companies in the traffic signalling business but it is only asserted that three of these companies manufacture or distribute *vehicle actuated traffic signals*. The business of the Gamewell Company, the General Electric Company, the Crouse-Hinds Co., the Westinghouse Electric & Manufacturing Company and the Signal Service Corporation in traffic signals is entirely irrelevant.

Of the three companies asserted to manufacture or distribute *vehicle actuated traffic signals* the Eagle Signal

Corporation is, as stated by respondent, a sub-licensee of Automatic Signal Corporation, the licensee of respondent (R. 142) and obviously its location in the Seventh Circuit would not be apt to produce further litigation.

Of the other two companies mentioned, the Pioneer Sales Corporation was a selling agent for Hayes Electric Manufacturing Company and we are informed by Mr. Hayes of the latter company that Pioneer Sales Corporation has been out of business since 1940.

At the time the petition was filed, petitioner believed that Hayes Electric Manufacturing Company was no longer in the traffic signal business. It was never an important factor in this business as it never manufactured complete *vehicle actuated traffic signals* but has merely made a detector and an adapter to be attached to prefixed time traffic signals to convert them to *vehicle actuated traffic signals*. In a few isolated instances petitioner has met competition from this company on proposed installations. Such instances have been many years ago and petitioner felt certain the statement that it and respondent's licensee were the only manufacturers of *vehicle actuated traffic signals* was a true statement.

Petitioner's attorney talked to Mr. Hayes, the President of this company, by telephone since the receipt of respondent's brief and verified that the Hayes Company manufactures only a detector and adapter. He was also advised by Mr. Hayes that the device made by his company is substantially in accordance with the disclosure of United States Letters patent 2,171,124. The device disclosed in that patent is quite different from the device made by petitioner, contrary to the statement appearing on page 4 of respondent's brief.

Therefore even though it might technically be said that Hayes Electric Manufacturing Company distributes or installs *vehicle actuated traffic signals*, its position in the

industry is such that we believe the improbability of litigation involving the patent in any other circuit is just as great as if this company did not exist and that the third reason relied upon for granting the writ is a good and valid reason.

Respectfully submitted,

DANIEL V. MAHONEY,
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247 Park Avenue,
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New York, N. Y.,
April 19, 1945.